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10/573,692	03/27/2006	Pascale Lacan	ESSR:111US/10603706	7189
32425 7590 07/07/2009 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			EXAMINER ROBINSON, ELIZABETH A	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-22 and 25-43 are currently being examined.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 20-22, 25, 26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 20-22, 25, 26 and 28 claim materials or properties for the outermost layer of the lens of claim 19. The outermost layer of the lens of claim 19 is the electrostatically adhered peelable film. There is no support in the instant specification for such a film being made of the materials of claims 20-22, 25 and 26 or having the surface energy of claim 28.

**Claims 19-22 and 25-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The term "amount sufficient to provide adhesion of the lens to a holding pad" in claim 19 is a relative term which renders the claim indefinite. The term "amount sufficient to provide adhesion of the lens to a holding pad" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no indication of how much of the surface must be covered or what degree of adhesion (providing some adhesion versus providing all adhesion) is required in order to meet the limitations of claims 19. All other claims depend from claim 19 and thus, are also rendered indefinite.

Regarding claims 20-22, 25, 26 and 28, the outermost layer of the lens of claim 19 is the electrostatically adhered peelable film. Such a film would not be made of the materials of claims 20-22, 25 and 26 or necessarily have the surface energy of claim 28. In order to further prosecution, the Examiner is interpreting that these claims limit the material for the outermost layer of the temporary protective coating.

***Claim Rejections - 35 USC § 102***

**Claims 19, 20 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohlin (US 5,792,537).**

Regarding claims 19 and 20, Ohlin teaches an optical lens with a marking formed from a removable ink (protective coating that has an outer layer that is mechanically alterable through friction and/or contact) formed on the lens surface and then covered with a removable mask (Ohlin, claim 1). The preferred material for the mask is a static cling vinyl (Column 6, lines 33-45). The marking ink is present on the surface of the lens and thus, is present in a sufficient amount to provide some degree of adhesion to a holding pad. As claimed, the temporary protective layer is not required to adhere to a holding pad, only that it would be present in a sufficient amount to provide some degree of adhesion to a holding pad

Regarding claims 33-36, Ohlin (Column 6, lines 33-45) teaches that the plastic material film is preferably a polyvinyl chloride film that contains 49 to 57 percent plasticizer.

***Claim Rejections - 35 USC § 103***

**Claims 19-22, 25-36 and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641), in view of Ohlin (US 5,792,537).**

Regarding claims 19-22, 25, 26, and 33-36, Conte (Page 3, line 29 through Page 4, line 6) teaches an ophthalmic lens comprising a temporary protective layer. The temporary protective layer can be formed from  $MgF_2$  (Page 6, lines 16-24). The

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temporary protective layer can be removed by dry wiping (Page 10, lines 25-29). For the trimming (edging) operation, the temporary protective layer is present in order to contact the self adhesive chip or double sided adhesive attached to a lens holding means (Page 8, lines 18-34). The temporary protective layer is in a sufficient quantity to provide some degree of adhesion to the lens holding means. The lenses comprising the temporary coating can be marked with inks used by the man in the art for progressive lenses (Page 11, lines 10-12).

Conte does not teach coating the protective layer with a peelable film.

Ohlin (Column 3, lines 26-50) teaches a mask that is adhered over markings on the surface of a lens to protect the markings from removal during subsequent processing. One use of these markings is to ensure that progressive lenses are properly aligned (Column 2, lines 10-32). The preferred material for the mask is a static cling polyvinyl chloride film that contains 49 to 57 percent plasticizer. Ohlin (Column 3, lines 37-58) teaches that the mask should not cover any area larger than is necessary to cover the markings and is not so large as to interfere with the adhesion of the tape that adheres the lens to the block (holding pad).

It would be obvious to one of ordinary skill in the art to use the mask of Ohlin, over the ink markings of Conte, in order to ensure that the markings are protected from removal during subsequent processing, such as when the adhesive holding the lens to the holding pad during the edging process is removed, while still providing a sufficient surface of the lens with the temporary protective layer exposed, to adhere the lens to the holding apparatus.

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Regarding claim 27, Conte (Page 6, lines 3-5) teaches that the inorganic (mineral) protective layer has a preferable thickness of 5 to 200 nm.

Regarding claim 28, Conte (Page 8, lines 31-34) teaches that the protective layer has a surface energy of at least 15 mJoules/m<sup>2</sup>.

Regarding claims 29 and 30, Conte (Page 6, lines 1 and 2) teaches that the protective layer is preferably continuous.

Regarding claim 31, Conte (Page 6, lines 32 and 33) teaches that the temporary protective layer can have multiple layers.

Regarding claim 32, Conte (Page 7, lines 20-22) teaches that the protective layer can be formed by vapor phase deposition.

Regarding claim 38, Conte (Page 6, lines 16-19) teaches that the protective layer is coated on a hydrophobic and/or oleophobic surface coating.

Regarding claims 39 and 40, Conte (Page 4, lines 29-34) teaches that the hydrophobic and/or oleophobic surface coating preferable has a surface energy lower than 12 mJoules/m<sup>2</sup>.

Regarding claims 41 and 42, Conte (Page 5, lines 17-22) teaches that the hydrophobic and/or oleophobic surface coating preferably has a thickness from 2 to 5 nm.

Regarding claim 43, Conte (Page 4, line 25-28) teaches that the hydrophobic and/or oleophobic surface coating is generally applied to lenses comprising an antireflecting coating.

**Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlin (US 5,792,537), in view of Mascarenhas et al. (US 5,888,615).**

Regarding claim 37, as stated above, Ohlin teaches a lens that meets the limitations of claim 19 and states that it is preferred that the plastic material film is a polyvinyl chloride cling film.

Ohlin does not explicitly state the thickness of the film.

Mascarenhas (Column 2, lines 1-15) teaches that most cling films are vinyl chloride films that comprise 50-55 weight % plasticizer and have thicknesses from about 0.004 to 0.014 inches (101 to 355 microns).

The thickness of the film of Ohlin either meets the thickness limitation of the instant claim or it would be obvious to one of ordinary skill in the art to use a film with a thickness that has been shown to be effective for cling films as taught by Mascarenhas.

### ***Response to Arguments***

Applicant's arguments filed April 7, 2009 have been fully considered but they are not persuasive.

Applicant argues that the ink markings of Ohlin (US 5,792,537) do not provide sufficient surface area to obtain satisfactory adhesion of the lens to a holding pad. However, the degree of adhesion required is not specified (for example, providing some adhesion versus providing all adhesion). Since the ink is present, it would be in an amount sufficient to provide some degree of adhesion.



Applicant argues that the ink marking of Ohlin are not in a position suitable to obtain adhesion to the holding pad and thus, tape is required. However, as claimed the temporary protective layer is not required to adhere to the holding pad, only that it would be present in a sufficient amount to provide some degree of adhesion to a holding pad.

Applicant argues that the trimming process of Conte et al. (WO 03/057641) does not utilize a mounting block or adhesive tape and thus, there would be no reason to use the protective film of Ohlin to protect the ink marking on the surface of the temporary protective layer. However, the trimming operation uses an acorn (mounting block) and a self-adhesive chip (double sided adhesive) between the acorn and the lens convex surface. Thus, the markings on the surface of the lens would need the protection, from the film of Ohlin, in order to not be removed when the adhesive is removed from the lens convex surface.

Applicant argues that the presence of the protective film of Ohlin would keep the protective layer of Conte from performing its function of adhering to the holding apparatus. However, Ohlin (Column 3, lines 37-50) teaches that the mask should not cover any area larger than is necessary to cover the markings and is not so large as to interfere with the adhesion of the tape. Thus, there would be a sufficient surface of the lens of Conte, with the protective layer exposed, to adhere the lens to the holding apparatus, while still protecting the ink markings.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Since both Conte and Ohlin use a tape layer to adhere to the holding apparatus, the Examiner maintains that the combination of these references is not based on improper hindsight.

Applicant argues that the ink of Conte would not be removed by the holding apparatus, since it is intended to contact the holding apparatus directly. However, Conte is silent on the removal of the ink and does not teach whether or not remarking of the lens would be required. Thus, the teachings of Conte do not teach away from the use of an additional material to protect the ink on the surface.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the electrostatic peelable film would sufficiently protect the temporary protective coating from mechanical degradation during transportation and/or storage) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding Applicant's request for rejoinder, given that the elected product claims and species remain rejected and are not in condition for allowance, rejoinder of the nonelected claims cannot be considered.

Due to amendments to claim 39, the claim objection from the January 7, 2009 Office Action is withdrawn.

Due to amendments to claim 19, the 35 U.S.C. 112, second paragraph rejections from the January 7, 2009 Office Action is withdrawn. The amendments to this claim have however resulted in new 35 U.S.C. 112, second paragraph rejections, as stated above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Robinson whose telephone number is

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(571)272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. R./  
Elizabeth Robinson  
Examiner, Art Unit 1794

June 29, 2009

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794